



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,237	05/23/2006	Christopher Penney	GRT/4141-20	1942
23117 7590 03/18/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
BALASUBRAMANIAN, VENKATARAMAN				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
03/18/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/580,237

**Applicant(s)**

PENNEY ET AL.

**Examiner**/Venkataraman  
Balasubramanian/**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 2-20 and 22-26 is/are allowed.  
6) ☒ Claim(s) 21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response filed on 11/28/2009 is made of record. Claims 2-26 are pending. In view of applicants' response, all 112 first and second paragraph rejections made in the previous office action have been obviated. However, the following new ground of rejection is applied to claim 21.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for rheumatoid arthritis, does not reasonably provide enablement for treating any or all inflammatory diseases and disorders generically claimed in the claim language. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Following apply:

Method claim 21 is drawn to treating inflammation by inhibition of  $\text{TNF-}\alpha$ , thereby treat any or all diseases including inflammatory diseases for which there is no enabling disclosure in the specification.

Instant claim 21, as recited, is a reach through claim. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

In the instant case, based on the inhibition of TNF- $\alpha$  by the instant compounds, claim 21 reaches through treating various diseases such as any or all inflammatory diseases and disorders in general and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, in the instant case, based on the mode of action of instant compounds as inhibitor of TNF- $\alpha$ , based on limited assay, it is claimed that treating any or all inflammatory diseases and disorders in general. The scope of the claims includes not only any or all disorders but also those conditions yet to be discovered as mediated by TNF- $\alpha$ , for which there is no enabling disclosure. In addition, the scope of these claims includes treatment of various diseases, which is not adequately enabled solely based on the inhibition of TNF- $\alpha$  assay provided in the specification at pages 59-74.

As for inhibiting cytokine TNF- $\alpha$  and thereby treat any or all diseases including inflammatory diseases and immunological diseases, specification has again no enabling disclosure and there is no support for any or all diseases embraced in these claims. Specification has no showing that any disease can be treated with instant compounds.

Scope of the claims not only include treating any or all inflammatory and autoimmune diseases and disorders, in general but also more specifically treating various diseases including systemic lupus erythematosus, immune thrombocytopenia, glomerulonephritis, vasculitis and arthritis such as rheumatoid arthritis, psoriatic arthritis, psoriasis, Crohn's disease, inflammatory bowel disease, ankylosing, spondylitis, Sjogren's syndrome, Still's disease (macrophage activation syndrome), uveitis,

scleroderma, myositis, Reiter's syndrome and Wegener's syndrome with the instant compounds.

Enablement for the scope of "inflammation" generally is not present. For a compound or genus to be effective against inflammation generally is contrary to medical science. Inflammation is a process, which can take place individually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the inflammatory reaction. There is no common mechanism by which all, or even most, inflammations arise. Mediators include bradykinin, serotonin, C3a, C5a, histamine, assorted leukotrienes and cytokines, and many, many others. Accordingly, treatments for inflammation are normally tailored to the particular type of inflammation present, as there is no, and there can be no "magic bullet" against inflammation generally. Inflammation is the reaction of vascularized tissue to local injury; it is the name given to the stereotyped ways tissues respond to noxious stimuli. These occur in two fundamentally different types. Acute inflammation is the response to recent or continuing injury. The principal features are dilatation and leaking of vessels, and recruitment of circulating neutrophils. Chronic inflammation or "late-phase inflammation" is a response to prolonged problems, orchestrated by T-helper lymphocytes. It may feature recruitment and activation of T- and B-lymphocytes, macrophages, eosinophils, and/or fibroblasts. The hallmark of chronic inflammation is infiltration of tissue with mononuclear inflammatory cells. Granulomas are seen in certain chronic inflammation situations. They are clusters of macrophages, which have stuck tightly together, typically to wall something off. Granulomas can form with foreign

bodies such as aspirated food, toxocara, silicone injections, and splinters. Otitis media is an inflammation of the lining of the middle ear and is commonly caused by *Streptococcus pneumoniae* and *Haemophilus influenzae*. Cystitis is an inflammation of the bladder, usually caused by bacteria. Blepharitis is a chronic inflammation of the eyelids that is caused by a staphylococcus. Dacryocystitis is inflammation of the tear sac, and usually occurs after a long-term obstruction of the nasolacrimal duct and is caused by staphylococci or streptococci. Preseptal cellulitis is inflammation of the tissues around the eye, and Orbital cellulitis is an inflammatory process involving the layer of tissue that separates the eye itself from the eyelid. These life-threatening infections usually arise from staphylococcus. Hence, these types of inflammations are treated with antibiotics. Certain types of anti-inflammatory agents, such as non-steroidal anti-inflammatory medications (Ibuprofen and naproxen) along with muscle relaxants can be used in the non-bacterial cases. The above list is by no means complete, but demonstrates the extraordinary breadth of causes, mechanisms and treatment (or lack thereof) for inflammation. It establishes that it is not reasonable to any agent to be able to treat inflammation generally.

The same applies to autoimmune diseases. The "autoimmune diseases" are a process that can take place in virtually any part of the body. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the inflammatory reaction. There are hundreds such diseases, which have fundamentally different mechanisms and different underlying causes. Thus, the scope of claims is extremely broad.

Applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host. Moreover many if not most of diseases such as autoimmune diseases such as lupus, AIDS, psoriasis, lung cancer, brain cancer, pancreatic cancer, colon cancer etc. are very difficult to treat and despite the fact that there are many agents whose mode of action is said to alleviate inflammation.

The scope of the claims involves of compounds of claim 2 and 25 as well as the thousands of diseases embraced by the term inflammation.

No compound has ever been found to treat diseases of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "compound" is contrary to our present understanding of modern medicine.

Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support *in vivo* uses.

Next, applicant's attention is drawn to the Revised Utility and Written Description Guidelines, at 66 FR 1092-1099, 2001 wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the

requirement for undue experimentation. See Tracey et al., Pharmacology & Therapeutics, 117, 244-274, 2008 and Bradley, J.R., Journal of Pathology, 214(2): 149-160, 2008. Note all these references indicate need for further studies for establishing the role of cytokine TNF- $\alpha$ .

Also, note MPEP 2164.08(b) which states that claims that read on "... significant numbers of inoperative embodiments would render claims nonenabled when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative.". Clearly that is the case here.

In evaluating the enablement question, several factors are to be considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

- 1) The nature of the invention: Therapeutic use of the compounds in treating any or all inflammatory diseases and disorders that require TNF- $\alpha$  inhibitory activity.
- 2) The state of the prior art: Recent publication expressed that the TNF- $\alpha$  inhibition effects are unpredictable and are still exploratory. See Tracey et al., and Bradley cited above.
- 3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical



use for treating any or all inflammatory diseases and disorders, in general and more specifically systemic lupus erythematosus, immune thrombocytopenia, glomerulonephritis, vasculitis and arthritis such as rheumatoid arthritis, psoriatic arthritis, psoriasis, Crohn's disease, inflammatory bowel disease, ankylosing, spondylitis, Sjogren's syndrome, Still's disease (macrophage activation syndrome), uveitis, scleroderma, myositis, Reiter's syndrome and Wegener's syndrome in a mammal with the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating any or all inflammatory diseases and disorders, and the state of the art is that the effects of TNF- $\alpha$  inhibitors are unpredictable. See Tracey et al., and Bradley cited above.

6) The breadth of the claims: The instant claims embrace treating any or all inflammatory diseases and disorders, mediated by TNF- $\alpha$ , which would include thousands and thousands of diseases and disorders.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant

case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was 'filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

***Allowable Subject Matter***

Claims 2-20 and 22-26 are allowed.

**Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any

inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/  
Primary Examiner, Art Unit 1624